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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,699	05/10/2001	Bernd-Georg Pietras	MRKS/0029	8491

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EXAMINER

OMGBA, ESSAMA

ART UNIT PAPER NUMBER

3726

DATE MAILED: 10/08/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/762,699

Applicant(s)

PIETRAS, BERND-GEORG

Examiner

Essama Omgba

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-9, 11, 12 and 14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Stogner (US Patent 5,255,751).

Stogner discloses a method for facilitating the connection of tubulars using a top drive, the method comprising the steps of adjusting a supporting member 22 supporting a tool 23 to cause the tool to be displaced horizontally relative to the top drive, see column 2, lines 24-26, column 4, lines 1-11, 67 and 68, and column 5, lines 1-3. Applicant should note that it is inherent that the supporting member of Stogner is attached to a top drive not shown in the drawing as is known in the art.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 and 5-9, 11, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stogner in view of Boyadjieff (US Patent 4,625,796).

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With regards to claims 1, 2, and 12, Stogner discloses an apparatus for facilitating the connection of tubulars using a top drive, the apparatus comprising a supporting member 22 for supporting a tool 23 and a means for allowing substantially horizontal and vertical movements of the supporting member, see column 2, lines 24-26, column 4, lines 1-11, 67 and 68, and column 5, lines 1-3. Stogner does not disclose a plate attachable to the top drive. However Boyadjieff teaches a plate 48 attachable to a top drive 19 of an apparatus for connecting tubulars. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have attached the top drive of Stogner to a plate, in light of the teachings of Boyadjieff, as is conventional in the art. For claim 3, see element 25.

For claim 5, the spring members of Stogner are equivalent to Applicant's pitons and cylinder arrangement. Furthermore, it is within the general knowledge of one of ordinary skill in the art to use a cylinder and piston arrangement for vertical displacement of members.

For claim 6, see column 5, lines 35-39 of Boyadjieff.

For claim 7, Applicant should note that the provision of a mud pipe is conventional in the art, see element 49 for example in Boyadjieff.

For claim 8, even though Boyadjieff does not disclose the mud pipe moveable in relation to the plate and the supporting member about ball joints, however it would have been obvious to one of ordinary skill in the art at the time the invention was made that the provision of ball joints for the movement of the mud pipe is a matter of design choice

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wherein no stated problem is solved or unexpected results obtained in using ball joints to move the mud pipe versus the arrangement taught by Boyadjieff.

For claim 9, see column 4, lines 10 and 11 of Stogner. Applicant should note that using a hydraulic motor as a supporting member is a matter of design choice wherein no stated problem is solved or unexpected results obtained in using a hydraulic motor for the supporting member versus the arrangement taught by Stogner.

For claim 11, supporting member 22 is integral with tool 23.

For claim 14, Stogner discloses a method for facilitating the connection of tubulars using a top drive, the method comprising the steps of adjusting a supporting member 22 supporting a tool 23 to cause the tool to be displaced horizontally relative to the top drive, see column 2, lines 24-26, column 4, lines 1-11, 67 and 68, and column 5, lines 1-3. Although Stogner does not structurally show how the top drive is connected to the tool, however Boyadjieff teaches a conventional arrangement of a top drive 19 with a plate 48 that is connected to a tool 21. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made that the tool of Stogner is connected to the top drive via plate supporting member 22, in light of the teachings of Boyadjieff, as is known in the art.

Allowable Subject Matter

5. Claim 4 is allowed.

Response to Arguments

6. Applicant's arguments filed on June 27, 2003 have been fully considered but they are not persuasive.

In response to Applicant's argument that Stogner does not teach, disclose or even suggest a supporting member for supporting a tool and a means for allowing substantially horizontal movement of the supporting member, the examiner respectfully disagrees. As outlined in the rejection, member 22 in Stogner is the supporting member that supports a tool 23 (a rotatable jaw that is used to apply torque to the pipe, see column 4, lines 49-51). Spring biased legs 24 support member 22 and allow for lateral and longitudinal play of member 22, see column 4, lines 1-6 and column 5, lines 1-3. In as much as lateral play represents a horizontal movement, the examiner maintains that Stogner teaches horizontal movement of the supporting member and since tool 23 is supported on member 22, movement of member 22 will inherently cause movement of tool 23.

In view of the above remarks, the examiner maintains that a *prima facie* case of obviousness has been established in the instant application as it relates to claims 1-3, 5-9, 11, 12 and 14.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (703) 305-2915. The examiner can normally be reached on M-F (10-7:30) First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (703) 308-1513. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

eo 
October 3, 2003


GREGORY VIDOVICH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700